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C. Orla
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PATENT

Attorney Docket No. 08130.0058

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Martin SCHADT et al.

Application No.: 09/719,303

§ 371 Filing Date: December 11, 2000

) Group Art Unit: 1772 ✓

) Examiner: Sow Fun Hon ✓

For: ✓OPTICAL COMPONENT, ORIENTATION LAYER, AND LAYERABLE POLYMERISABLE MIXTURE

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

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Response to Restriction Requirement

This communication responds to the Office Action dated October 9, 2002, which set a one month period of time for reply.

Claims 1-29 are pending in this application. The Examiner required applicants to elect one of the following groups of inventions for examination:

Group I: claims 1-25

Group II: claims 26-29.

The Examiner stated that the cited groups of claims are not linked so as to form a single general inventive concept under PCT Rule 13.1. The Examiner stated that evidence of the lack of unity of invention is found in Schadt et al., Japanese Journal of Applied Physic, vol. 31, pp. 2155-2164 (1992), which has been made of record in this application.

Applicants elect, with traverse, the claims of Group I for examination (i.e., claims 1-25). The Examiner provided one reason for the restriction, namely, that "[e]vidence of lack of unity is found between the groups in Schadt et al." That statement is not sufficient to establish lack of unity of invention. The Examiner has not indicated what particular relevant "evidence" exists in the cited Schadt article and how that "evidence" would dictate whether the pending claims lack unity of invention. Further, the Examiner's position is inconsistent with the findings in the International Preliminary Examination Report for this application. The officer who prepared that

Report offered no objection at all to unity of invention. The claims now pending correspond substantially to the same claims reviewed in that Report. Thus, unless the Examiner can clearly demonstrate otherwise, there is not a unity of invention problem with the claims of this application.

The Examiner also stated that "the special technical features of the claimed invention are not found to define a contribution over the prior art." Applicants disagree. The International Search Report to this application identifies the cited Schadt article as a category "A" document, meaning that it is a "document defining the general state of the art which is not considered to be of particular relevance." If the Examiner does not believe that the claimed invention is patentable over the prior art, then an appropriate rejection should be made on the merits.

Even if the restriction requirement is maintained, the Examiner should nonetheless re-join claims 26-29 for examination in this same application once the composition of claim 1 is found allowable. Claims 26-28 recite processes that incorporate the product of claim 1 in Group I, and claim 29 recites a product made by the process of claim 26. The rejoinder rules of MPEP § 821.04 state that "if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitation of the allowable product claim will be rejoined." In light of the above, applicants respectfully request that the Examiner examine all pending claims together in this application.

If there is any fee due in connection with the filing of this Response to Restriction Requirement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By:


Steven J. Scott

Reg. No. 43,911

Date: November 1, 2002